

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUSTAVO PALACIO, MARIA CLARA GARCIA,
PABLO RAMIREZ and BERNARDO VANEGAS

MAILED

SEP 28 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-2678
Application 09/992,110

ON BRIEF

Before WARREN, OWENS and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 27, all of the claims in the application.

Claim 1 illustrates appellants' invention of a method of recycling bonded fibrous materials, and is representative of the claims on appeal:

1. A method of recycling bonded fibrous materials, the method comprising,
providing pieces of bonded fibrous materials comprising synthetic fibrous material, the pieces having sizes that are adapted for suspension in a liquid;
suspending the discrete pieces of bonded fibrous materials in a liquid;
applying mechanical work to the liquid suspension of discrete pieces to generate hydraulic pressure and mechanical shear stress conditions sufficiently to hydraulically fragment the bonded fibrous materials into fibers and fiber-like components; and
separating substantially individual fibers and fiber-like components from the liquid.

The references relied on by the examiner are:

Didwania et al. (Didwania)	4,725,682	Apr. 5, 1988
Milding et al. (Milding)	WO 96/06222	Feb. 17, 1996
(published World Intellectual Property Organization Application)		

The examiner has rejected appealed claims 1 through 27 under 35 U.S.C. § 103(a) as being unpatentable over Didwania in view of Milding (supplemental answer,¹ pages 3-4). The examiner has further provisionally rejected appealed claims 1 through 27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 20 of copending application 10/012,768, and over claims 1 through 20 of copending application 10/012,766 (supplemental answer, page 4).

Appellants group the appealed claims as claims 1 through 16 and claims 17 through 27, and present argument as to claim 1 and claim 17 with respect to the grounds of rejection under § 103(a) (amended brief, pages 4, 8 and 9).² Appellants address the claims in the second ground of rejection as a group (brief, pages 9-10). Thus, we decide this appeal based on appealed claims 1 and 17 as representative of the grounds of rejection and appellants' groupings of claims. 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm the provisional grounds of rejection under the judicially created doctrine of obviousness-type double patenting, and reverse the ground of rejection under § 103(a). Accordingly, the decision of the examiner is affirmed.

We refer to the supplemental answer and to the amended brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

Opinion

The dispositive issue in this appeal is whether one of ordinary skill in this art would have found in the combined disclosures of Didwania and Milding, teachings and inferences which would have led this person to use "bonded fibrous materials comprising synthetic fibrous material" as required by the claimed method encompassed by appealed claim 1 that are disclosed by Milding in place of the latex bonded broke or paper containing latex in the method for

¹ We consider the supplemental answer mailed June 20, 2005.

² We consider the amended brief filed October 29, 2004.

recovery of cellulosic fibers which are not separated from the latex in the method disclosed by Didwania.³ The examiner finds that Didwania would have disclosed the claimed method to one of ordinary skill in the art but for the application thereof to latex bonded cellulosic material, and determines that one of ordinary skill in this art would have been motivated to apply the Didwania method to the bonded woven and nonwoven synthetic fiber containing fabric because Milding teaches at page 3, ll. 10-29, that such materials can be broken down to recycle fibers which comprise synthetic fiber (supplemental answer, page 3). Appellants submits, with respect to appealed claim 1, that there is no suggestion in Didwania to extend the use of the method therein beyond latex bonded cellulosic material to include the bonded woven and nonwoven synthetic fiber containing fabric which Milding recycles with mechanical shredding that contains no liquid, and similarly, that there is no evidence that one of ordinary skill in this art working with the fabric recycled by Milding would consider using the method of Didwania for that purpose (amended brief, e.g., pages 6-7; reply brief, e.g., unnumbered pages 1-2).

We agree with appellants. We find no evidence that, without more, one of ordinary skill in this art would have equated the shredding of bonded woven and nonwoven synthetic fiber containing fabric in the apparently dry mechanical shredding method of Milding with shredding latex bonded cellulosic material in the liquid mechanical defiberization method of Didwania based alone on the desire to recycle waste material, which is the basis for the examiner's rejection. *Cf. In re Siebentritt*, 372 F.2d 566, 567-68, 152 USPQ 618, 619 (CCPA 1967) (express suggestion to interchange methods which achieve the same or similar results is not necessary to establish obviousness). Indeed, we find no disclosure in Milding of any latex bonded paper waste or materials which include latex bonded cellulosic materials.

With respect to appealed independent product-by-process claim 17, which differs from appealed product-by process claim 16, dependent on appealed claim 1, in the limitation that the claimed synthetic fiber and fiber-like materials comprise "at least one thread element composed

³ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

of synthetic material having at least one irregular distortion generated by hydraulic fracture of the thread element to separate it from a bonded fibrous material while the bonded fibrous material is suspended in a liquid” without other limitation with respect to the method, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *see also generally, In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), the examiner relies on the position taken with respect to Didwania and Milding for the finding that “a fiber having the irregular distortion would necessarily be produced” (supplemental answer, page 7). We agree with appellants (amended brief, page 9) that there is no evidence in the record to support the examiner’s position which apparently is based on inherency.

Accordingly, we find that the examiner has failed to establish a *prima facie* case of obviousness, and therefore, we reverse the ground of rejection of the appealed claims under 35 U.S.C. § 103(a). *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained).

We summarily affirm the provisional grounds of rejection under the judicially created doctrine of obviousness-type double patenting because appellants have stated the intention to file “appropriate terminal disclaimers. . . if necessary, upon the allowance of claims in the present application” to obviate these grounds (amended brief, pages 9-10).

The examiner’s decision is affirmed.

Remand

We remand the application to the examiner for consideration of issues raised by the record. 37 CFR §1.41.50(a)(1) (September 2004); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

The record does not show that the claimed fiber and fiber-like materials encompassed by product-by-process claim 16, the claimed recycled synthetic fibers and fiber-like materials encompassed by product-by-process claims 17 through 24, and the claimed nonwoven fibrous web comprising the recycled synthetic fibers and fiber-like material of claim 17 encompassed by

product-by-process claims 25 through 27, have been separately considered with respect to the recycled synthetic fibers and fiber-like materials taught by Milding alone. *See generally, Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Wertheim*, 541 F.2d 257, 271, 191 USPQ 90, 103-04 (CCPA 1976) (“These claims are cast in product-by-process form. Although appellants argue, successfully we have found, that the [reference] disclosure does not suggest . . . appellants’ process, the patentability of the products defined by the claims, rather than the processes for making them, is what we must gauge in light of the prior art.”).

We suggest that the examiner consider whether the “at least one irregular distortion generated by hydraulic fracture of the thread element to separate it from a bonded fibrous material” required of the products claimed in the above claims, as illustrated in specification **FIGs. 3 through 8 and 10 through 14**, would reasonably appear to occur in the recycled synthetic fibers and fiber-like materials obtained from the mechanical shredding method of Milding, and the nonwoven materials prepared therewith as taught by the reference.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider the issue we raise above with respect to appealed claims 16 through 27, supplying and applying any other applicable prior art in this ground as the examiner deems appropriate.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).

In view of the above remand to the examiner for further prosecution of this application, this decision is not final for purposes of judicial review. 37 CFR §1.41.50(e) (September 2004).

AFFIRMED

REMANDED


CHARLES F. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS

Administrative Patent Judge

pts F. Kent

PETER F. KRATZ
Administrative Patent Judge

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